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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/659,502	<b>Applicant(s)</b> NASSIF ET AL.	
	<b>Examiner</b> Lauren Q Wells	<b>Art Unit</b> 1617	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-21 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 29, 30 and 32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-21, 26-28, 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-11, 13-21, 26-32 are pending. The Amendment filed 11/20/30, amended claims 1, 21, 26, 27, added claims 29-32, and cancelled claims 12, 22-24.

Applicant's amendment to the claims is persuasive-in-part to overcome the 35 USC 112 rejections in the previous Office Action. See below for the 35 USC 112 rejections that are maintained.

### ***Election/Restrictions***

Newly submitted claims 29-30 and 32 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 29-30 and 32 are directed toward Group II of the Restriction Requirement in the previous Office Action. For the reasons stated in the previous Office Action, Groups I and II are distinct inventions. Since Applicant elected Group I for examination, claims 29-30 and 32 are withdrawn from consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-30 and 32 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-21, 26-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) The rejection over the phrase “the liquid composition comprising” and the “said liquid composition consisting essentially of”, in claims 1 and 27, is maintained. A composition can not both comprise and consist essentially of. Applicant argues, “the term ‘consisting essentially of’ is in the more traditional legal sense, limiting the content of the solvents in the system to only water and alcohol, excluding any other solvent that provides any substantial functional effect. . This is not a contradiction in the use of the comprising language for the liquid composition. Other materials may be present, expect for solvents for the oil”. This argument is not persuasive. A composition cannot comprise and consist essentially of, as the transitional term “comprise” is open ended and does not exclude anything, and the transitional term “consist essentially of” is closed and excludes any ingredients that materially affect the composition. Additionally, the Examiner respectfully points out that for the purposes of searching for an applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. See MPEP 2111.03. In the instant case, aside from the vague and indefinite, issue, there is not a clear indication in the specification or claims of what the basic and novel characteristics actually are.

(ii) Claim 31 is vague and indefinite, as it is confusing. It is respectfully pointed out that a composition can not simultaneously comprise and consist of ingredients. See the above paragraph for the rationale.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-2, 4-21, 26-28, 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheung et al. (6,177,388).

Cheung et al. disclose an aqueous concentrated liquid composition for cleaning hard surfaces which blooms when added to a larger volume of water, which comprises botanical oil constituents and a binary solvent system which includes at least one organic alcohol and glycol. Peppermint oil, lavender oil, bergamot oil, rosemary oil, and sweet orange oil are disclosed as

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botanical oils. Isopropyl alcohol is disclosed as an organic alcohol. Larger volumes of water can be added to the composition. See Cols. 14-16, claims 1, 2, 8 and 17. Table 1 of Col. 12 exemplifies a composition comprising 4% peppermint oil, 12% isopropyl alcohol (additional component to effect a household function), water (additional component to effect a household function), and other ingredients. Thus, Cheung et al. and the instant invention teach a method of applying a composition to an inanimate surface for household cleaning purposes, comprising 4% of an aromatherapeutic essential oil, and solvents selected from water or alcohol. It is respectfully pointed out that applying the composition to the surface results in providing aromatherapy to persons within the ambient environment. It is respectfully pointed out, regarding the recitation "allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy", that this limitation is met because the moment an essential oil is released from a container, the aroma begins to circulate within an area, thereby providing aromatherapy. Cheung et al. and the instant invention also teach a composition comprising at least 0.2% of an antibacterial oil and a separate ingredient for effecting a household function.

Claim 21 is rejected under 35 U.S.C. 102(b) as being anticipated by Elliott (5,620,695).

Elliott exemplifies a composition comprising 96% carrier oil, 2% lavender (an antiseptic, an antiseptic which can effect a household function), 1% eucalyptus (antibacterial essential oil), 1% ti tree. See Col. 2, lines 31-39. Thus, Elliott and the instant invention both teach a composition comprising at least 0.2% of an antibacterial essential oil (eucalyptus) and an ingredient that effects a household function (lavender).

The Examiner respectfully points out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in

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order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended use of the instant composition claim is not given patentable weight.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cheung et al. as applied to claims 1-2, 4-21 and 26-28, 31 above.

The instant invention is directed toward a method for providing aromatherapy to persons or animals within an ambient environment comprising directly applying a composition consisting of a liquid composition to an inanimate surface to effect a household function selected from surface cleaning, surface shining, degreasing, cleansing, foreign matter removal, moisturizing, dish soaps, and iron liquids, the liquid composition comprising an aromatherapeutic concentration of an aromatherapeutic essential oil of 0.1-20%, completing the household function, allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the ambient environment, the solvents in said liquid composition consisting essential of materials selected from water and alcohols; a

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composition comprising a liquid composition comprising 0.2% of an antibacterial essential oil and a separate ingredient that effects a household function.

Cheung et al. is applied as discussed above. The reference further teaches that the concentrate composition are particularly useful in the cleaning of surfaces composed of ceramics, glass, and metals. See Col. 11, line 64-Col. 12, line 17. The reference lacks an exemplification of cleaning these specific surfaces.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify a method of cleaning ceramic, glass or metal using the composition exemplified by Cheung et al. because Cheung et al. teach their compositions as particularly useful for cleaning ceramic, glass, and metal.

Claims 1-2, 4-20, 26-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. (6,045,813).

Ferguson et al. teach lotions and gels with active ingredients in beads. Exemplified is a method of treating a surface with an active ingredient comprising providing a carrier liquid, disbursing in the carrier liquid a multiplicity of visible friable beads, each containing from about 0.5 to about 5% by weight active ingredient for treating the surface, dispensing the carrier with beads through a dispenser pump onto a surface; and using the carrier with beads on the surface, at least one of the steps of dispensing or the step of using the beads on the surface, causing fracturing of the beads to spill their contents and mix it with the carrier liquid. An essential fragrance oil is taught as the active ingredient. The composition is taught for use as a household cleanser. Alcohol and water are taught as carriers. Essential oils are taught as comprising 0.5-3% of the composition and chamomile extract is taught as an essential oil. Thus, both Applicant



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and Ferguson et al. disclose liquid cleaning compositions that are applied to hard surfaces, wherein the composition comprises aromatherapeutic essential oils and wherein aromatherapy is provided to persons within the ambient environment of the cleaned hard surface. The reference lacks an exemplification of effecting a household function. See Col. 1, line 5-Col. 2, line 65; Col. 8, line 57-Col. 12, line 64.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Ferguson et al. to exemplify a method of treating a surface for household cleansing with an 0.5-5% of an essential oil and carrier because Ferguson et al. specifically teach their method for household cleaning and because of the expectation of achieving a cleansing product that smells good.

Regarding the limitation “allowing the aromatherapeutic essential oil to remain within the ambient environment to effect aromatherapy on persons or animals within the ambient environment”, it is respectfully pointed out that this limitations is met because Ferguson et al. teach their methods as imparting fragrance upon cleaning.

It is respectfully pointed out that Ferguson et al. teach separate compositions for use on surfaces (ceramic, glass, metal. . .), since the compositions of Cheung et al. can contain varying amounts of ingredients.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al. as applied to claims 1-2, 4-20, 26-28 above, and further in view of Durbut et al. (6,022,839).

Ferguson et al. is applied as discussed above. The reference lacks preferred household functions.

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Durbut et al. teach all purpose liquid cleaning compositions comprising essential oils. The compositions are taught for cleaning hard surfaces such as painted woodwork, tiled walls, tile floors, bathtubs, and metal surfaces. See Col. 1, lines 10-67; Col. 5, line 27-Col. 6, line 9.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the household functions of Durbut et al., such as cleaning woodwork, tile, and metal surfaces, in the invention of Ferguson et al. because Ferguson et al. broadly teach their compositions for cleaning household surfaces and because of the expectation of achieving a product that can be formulated for multiple household tasks, thereby increasing the efficiency by which one cleans.

#### ***Response to Arguments***

Applicant argues, “The Cheung reference specifically requires at least one solvent in addition to water or alcohol. . .and the present claims exclude any solvent other than water and alcohol, Cheung does not anticipate the claims”. This argument is not persuasive. First, it is respectfully pointed out that for the purposes of searching for an applying prior art under 35 USC 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, “consisting essentially of” will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant’s invention. See MPEP 2111.03. Second, it is respectfully pointed out the instant claims both recite a liquid composition that comprises and consists of or consists essentially of. Given the confusion as outlined in the 35 USC 112 rejection above, the Examiner is giving this

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claim the broadest reasonable interpretation in light of the specification, and examining the claims, wherein the liquid compositions comprises, wherein “comprises” is an open-ended transitional term that does not exclude any ingredients.

Regarding the rejection of claim 21 over Elliot, Applicant argues, “This rejection is moot with the cancellation of claim 21 as belonging to a claim group that should have been restricted out”. This argument is not persuasive. The Applicant’s argument is confusing to the Examiner. Claim 21 is properly included in Group I of the Restriction requirement, wherein Applicant elected Group I for prosecution. Furthermore, as evidenced by the current listing of the claims, claim 21 is pending.

Regarding Ferguson, Applicant argues, “There is no direct application of the liquid composition to the surface. Direct means exactly that—application of the material directly without intermediate steps (such as rupturing of shells and using shells as an abrasive) to a surface”. This argument is not persuasive. The Examiner respectfully directs Applicant to Webster’s Dictionary’s definition of direct, to cause to turn, move, or point undeviatingly or to follow a straight course. The composition of Ferguson IS applied in such a manner. The rupturing of the shells is not an intermediate step. The rupturing occurs as a result of the method of applying the composition directly to a surface. Additionally, the Examiner respectfully points out that during patent examination, the pending claims must be ‘given the broadest reasonable interpretation consistent with the specification.’ See MPEP 2111. In the instant case, the method of Ferguson results in the direct contact of essential oil with a surface. Furthermore, the Examiner respectfully directs Applicant to col. 4, lines 28-36, which teaches that the beads can be fractured, spilling out the essential oil, even before the composition reaches the surface.

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Finally, the Examiner directs Applicant to claim 19 of Ferguson, which teaches a method of treating a surface with an active ingredient, wherein the active ingredient is an essential oil with beads, wherein the beads fracture in contact with the surface.

Applicant argues, "the botanicals would therefore constitute a maximum of . . .0.02%, well below the minimum recitation of 0.1% recited in the claims". This argument is not persuasive. It is respectfully pointed out that the claims of Ferguson teach the active ingredient (essential oil) as comprising 0.5-5% of the beads and teach the beads as comprising 0.5-10% of the composition. Thus, Ferguson teaches the essential oils in the range of the percent weights recited in the instant claims.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw

  
**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**